

REMARKS

The Office Action of May 26, 2005, has been considered by the Applicants. Claims 1 and 18 have been amended. Claims 12, 13, and 15 have been cancelled. Claims 1, 3-11, 14, 16, and 18-40 are pending. Reconsideration of the Application is requested.

Claims 13, 15, and 16, were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants traverse the objections.

Claim 13 has been cancelled. Claim 15 has been cancelled; claim 12 was also cancelled for the same reason. Claim 16 has not been cancelled because claim 1 has been amended so that it does not specify the same polymers as in claim 16. Claim 16 is therefore of proper dependent form. Applicants request withdrawal of the objections under 37 CFR 1.75(c).

Claims 1, 3-7, 10, 12-16, 20, 21, 23, 26, 28-30, 36, 37, 39, and 40 were rejected under 35 U.S.C. 102(b) as anticipated by Kasuya 5,480,759. Applicants traverse the rejection.

The Examiner refers to Production Example 7 (cols. 29, 30) as showing all claim limitations. Applicants note that the Examiner referred to 7.5 parts of a charge transporting triphenylamine whereas Kasuya stated 2.5 parts; however, this error did not affect the Examiner's reasoning.

Kasuya does not anticipate the instant claims. Kasuya teaches that the fluoropolymer is used in a protective layer, not in a charge transport layer as the present claim does. Applicants note that Kasuya always makes a clear distinction between the two layers.

Alternatively, Applicants note that the Examiner met the thickness limitation of claim 29 by using the “surface layer,” which was the combined charge transport layer and protective layer of Kasuya. In this case, claim 1 is not anticipated because it requires that the fluoropolymer be dispersed in the binder. The word “dispersed”, as used in the specification of the instant application, and as defined by Merriam-Webster, means that the fluoropolymer is evenly distributed throughout the entire charge transport layer. However, as is clear from Production Example 7, the fluoropolymer is not evenly distributed throughout the entire surface layer because it is present only in the protective layer. Therefore, claim 1 and its dependent claims are not anticipated by Kasuya. If the Examiner wishes to separate the two layers taught by Kasuya, then Applicants note that the thickness limitation of claim 29 is not met by the protective layer alone, which in various examples ranged from 3-6  $\mu\text{m}$ , and request a notice as to whether claim 29 itself would be allowable.

For these reasons, Applicants request withdrawal of the 102(b) rejections based on Kasuya.

Claims 8, 9, 11, 18, 19, 22, 24, 25, 27, 28, 31-35, and 38 were rejected under 35 U.S.C. 103(a) as obvious over Kasuya in view of various handbooks. Because Applicants’ arguments are not based on the handbooks, their names are omitted; this should not be construed as an admission of their teachings. Applicants traverse the rejections.

Claims 8, 9, 11, 18, 24, 25, 27, 28, 31-35, and 38 all depend from independent claim 1. A *prima facie* case of obviousness has not been made for claim 1 because, as discussed above, not all claim limitations of claim 1 are met. Any claims depending from a non-obvious claim are themselves non-obvious. MPEP § 2143.03; *In re Fine*.

Additionally, with regard to claim 18, Kasuya teaches perfluoroalkyl acrylates with the formula  $-\text{CH}_2\text{-CH}_2\text{-}(\text{CF}_2)_n\text{-CF}_3$ , where  $n$  is an integer of 4-16. This perfluoroalkyl chain corresponds to  $R_1$  or  $R_2$  of the claimed fluoropolymers as depicted in, e.g., claims 7 and 40. Kasuya’s perfluoroalkyl chain therefore requires a minimum of seven carbon atoms. However, the majority of the specific fluoroalkyl (methyl) acrylates listed in claim

18 do not have seven carbon atoms. Applicants have amended claim 18 to remove the two tridecafluoroctyl acrylates from the Markush group; however, the remaining ones are not made obvious by the teachings of Kasuya. Also, Kasuya does not teach the two fluorohydroxyalkyl acrylates remaining in the Markush group. Applicants request a specific notice as to whether claim 18 itself would be allowable on this basis.

With regard to independent claims 19 and 22, again, the specified fluoroalkyl (methyl) acrylates are not taught by Kasuya because they all have less than seven carbon atoms in the fluoroalkyl chain.

Kasuya does not teach or suggest the use of a fluoroalkyl chain having less than seven carbon atoms. His patent is directed to an imaging member where the surface layer contains a transition metal atom, preferably Fe, Ni, or Cr, in an amount of 0.1-10 ppm. He makes no specific teachings about the fluoroalkyl chain otherwise. MPEP § 2143.01.

For these reasons, Applicants request withdrawal of the 103(a) rejections based on Kasuya.

For the Examiner's information, Applicants note that copending application US Serial No. 10/369,816, which was cross-referenced in this application, was allowed on March 1, 2005; however, a patent number has not yet been assigned. Applicants will update its status when further information is available.

**CONCLUSION**

For the above reasons, all pending claims (1, 3-11, 14, 16, and 18-40) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,

FAY, SHARPE, FAGAN, MINNICH  
& McKEE LLP

*Richard Klein*  
Richard M. Klein (Reg. No. 33,000)  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, OH 44114  
(216) 861-5582